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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,749	07/12/2001	Robert Noodelijk	28967.0112	9603

7590 04/13/2006

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EXAMINER

HWU, JUNE

ART UNIT PAPER NUMBER

1661

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/902,749	Applicant(s) NOODELIJK, ROBERT	
	Examiner June Hwu	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

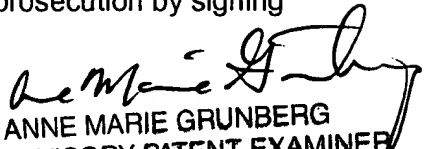
In view of the Remand from the Board of Patent Appeals and Interferences dated August 18, 2005 and the subsequent request for information filed on February 21, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER

Claim Rejections - 35 USC § 102

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Dutch Plant Breeder's Right (PBR) application number CHR3121 published on June 16, 1999, more than one year prior to the filing date of the instant application in view of Applicant's admission that the instant cultivar was first sold in the Netherlands on January 1999 (reply dated December 13, 2002, page 2) and also noted in the Plant Varieties Journal vol. 17, no. 1, 2004 that the first sale occurred in the Netherlands on January 15, 1999, and further in view of the Royal Horticultural

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Society Dictionary of Gardening 1992, vol. 1 describing how to asexually propagate a chrysanthemum.

The publications cited above disclose the claimed variety. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. One of ordinary skill in the art would have known where to obtain the claimed plant by searching the Internet for the breeder Chrysanthemum Breeders Association (see UPOVROM Plant Variety Database 2005/05 listing the breeder) at <<http://www.cba-nv.nl/index.cfm?act=Contact.formulier>>. By clicking on "Contact", one of ordinary skill could have contacted someone at Chrysanthemum Breeders Association by mail, telephone, fax or e-mail concerning the plant availability and/or where to purchase the plant. With regard to the reproducibility of the instant cultivar, a person skilled in the art would have the knowledge of reproducing the instant cultivar, given the notoriety of various methods of asexual propagation of a mum as shown by Royal Horticultural Society Dictionary of Gardening (pp. 612-618).

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications."). Moreover, the Court in *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states that a printed publication coupled with a foreign sale of the plant would constitute a bar under §102(b) on page 1040.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Polish PBR application number OO00739 published on March 31, 2000, more than one year prior to the filing date of the instant application in view of Applicant's admission that the instant cultivar was first sold in the Netherlands on January 1999 (reply dated December 13, 2002, page 2) and also noted in the Plant Varieties Journal vol. 17, no. 1, 2004 that the first sale occurred in the Netherlands on January 15, 1999 (p. 309), and further in view of the Royal Horticultural Society Dictionary Gardening 1992, vol. 1 describing how to asexually propagate a chrysanthemum.

As stated above, the instant cultivar was described in a printed publication and one skilled in the art could have obtained or reproduced the instant cultivar because it was accessible to the public more than one year prior to the filing date of this instant application.

Response to Arguments

Applicant's arguments filed February 21, 2006 have been fully considered but they are not persuasive.

Applicant argues that the instant assignee would not have revealed any information as to where to purchase the instant cultivar until after December 12, 2001 (registration date of the PBR at the Dutch office) (p.1 of reply).

This argument has not been found persuasive because the instant cultivar was placed in the public domain more than one year prior to the U.S. filing date of this application as evidenced by Applicant admission along with the Plant Varieties Journal that the sale of the instant cultivar occurred on January 1999, more than one year prior to the filing date of this application. Whether or not the assignee divulged any information regarding where to purchase the instant cultivar, the fact remains that the foreign sale occurred, more than one year prior to

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the filing of the instant application. In *In re Elsner* (72 USPQ2D 1038 (CA FC 2004), the Court states that the “publication of the applications coupled with foreign sales of the plants may constitute a §102(b) bar to patentability” (p. 1040). Moreover, the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. As in this case, the PBR applications were published more than one year prior to the filing date of this plant application and the admission of the sale along with the publication stating the sale of the instant cultivar as early as 1999 would be a bar under 102(b).

Applicant reiterates that the information regarding the variety was not available by the assignee if the breeder’s reference is used to identify the plant in the PBR (p. 2 of reply).

This argument has not been found persuasive because regardless of whether this may or may not have occurred, the plant was in the public’s possession more than one year prior to the U.S. filing date. The foreign sale was not an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Therefore, the plant was in the public domain and one of ordinary skill in the art could have obtained the plant after the plant was ready for sale and more than a year prior to the filing date of this instant application. The publication served as notice to the public that the plant existed. Sale of the plant, served to enable the publication. Additionally, asexual reproduction of chrysanthemum is well known in the art, for example, The New Royal Horticultural Society Dictionary of Gardening 1992, vol. 1, describes how to propagate a chrysanthemum (pages 614-617).

Applicant argues that reproduction of the claimed plant could not be because the public could not access technical information regarding the form of propagation or the breeding history (p. 2 of reply).

This argument has not been found persuasive because the method of propagating and the history of breeding the instant cultivar are immaterial as prior sale and the public knowledge

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of the plant would enable a person skilled in the art to obtain the plant and asexually reproduce it by means well known in the art of propagating chrysanthemum.

Conclusion

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH


ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER